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| In re Application of | : |
| Zion Azar | : |
| Application No. 09/828,997 | : DECISION ON PETITION |
| Filed: April 1, 2001 | : |
| Attorney Docket No. 127/02185 A07 | : |

This is a decision on the petition filed on January 24, 2005 by which petitioner requests that the finality of the rejection dated December 10, 2004 be held to have been premature, and requesting that prosecution be reopened. The petition is being considered under 37 CFR 1.181, and no fee is required for the petition.

The petition is granted.

Petitioner alleges that the Office action in question is incomplete because certain of the claims did not receive an action on the merits, but were erroneously held to be multiple dependent claims that are drafted in improper format. Petitioner further alleges that it was improper to make the Office action in question final because certain of the finally rejected claims that had not been amended after the prior action received a rejection on grounds differing from those set forth in the prior rejection.

A review of the record shows that in the final rejection dated December 10, 2004, the examiner included the following objection:

> "Claims 29-40 are objected to under 37 CFR 1 .75(c) as being in improper form because a multiple dependent claim must refer back to a preceding claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits."

It appears that this objection resulted from the fact that the amendment filed, on September 10, 2004 in response to a nonfinal Office action dated June 7 2004, added new independent claims, and amended certain dependent claims already of record having lower claim numbers than the newly added claims so that the dependent claims depended from the new independent claims having higher claim numbers.

A review of the record also shows that the amendment filed on September 10, 2004 included several claims that had been rewritten in independent form without any substantive change to the scope of the written claim. Claim 5 is one example. Claim 5 as amended on September 10, 2004 is identical in scope to claim 5 as rejected in the Office action dated June 7, 2004. Yet in the June 7, 2004 Office action, claim 5 was rejected under 35 USC § 102(b) over U.S. Patent No. 5,814,008, while in the final rejection dated December 10, 2004, claim 5 was rejected under 35 USC § 103 for obviousness over the '008 patent, taken with the examiner's statement as to why a particular limitation would have been obvious to one of ordinary skill in the art.

On the issue of the propriety of failing to act on the merits of the dependent claims that referred "back to" parent claims having higher claim numbers, MPEP § 608.01(n) is quite clear with respect to both single

dependent claims and multiple dependent claims. During prosecution of the application, it may be that a dependent claim will be presented as depending from a claim with a higher claim number. See MPEP §§ 608.01(n)( I(F), 4th paragraph and 608.01(IV), paragraph 3. Although it is proper for an examiner to remind an applicant for patent that the claims will be renumbered upon allowance so that all dependent claims refer back only to claims having lower numbers, there was no reason for the examiner to refuse consideration of the claims that were objected to on their merits when these claims were clear, and could be understood by the examiner. The failure to act on these claims was clearly erroneous.

MPEP § 706.07(a) is equally clear with respect to propriety of making an action final. This section states that:

> [u]nder present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement ... ."

Inasmuch as the Office Action dated December 5, 2004 rejected at least claim 5 on grounds differing from the ground of rejection applied against the claim in the previous Office action notwithstanding that the scope of claim 5 had not been substantively changed, it was clear error for the examiner to make the December 10, 2004 action final.

As it appears that the examiner's final action dated December 10, 2004 erroneously failed to treat certain dependent claims on their merits, and should not have been made final, petitioner is clearly entitled to the relief requested. The finality of the Office letter dated December 10, 2004 is hereby vacated. The application is being returned to the examiner *via* the Supervisory Patent Examiner of Art Unit 3739 who will prepare a new and nonfinal action treating all of the claims of record. The preparation of this action should be given priority.

PETITION GRANTED.

Richard A Bertsch, Director
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